



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,036	10/31/2003	Hiroki Nakajima	Q78242	8374

23373 7590 03/23/2006
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

MONSHIPOURI, MARYAM

ART UNIT PAPER NUMBER

1653

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/697,036	Applicant(s) NAKAJIMA, HIROKI	
	Examiner Maryam Monshipouri	Art Unit 1653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 11-17 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-10, 18-20 and 22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information-Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Applicant's response to restriction requirement filed 2/21/2006 is acknowledged. Applicant elected Group I invention directed to claims 1-10, 18-20 and 22 (only SEQ ID NO:41) without traverse. Claims 11-17 and 21 as well as SEQ ID NO:55 and 68 are hereby withdrawn as drawn to non-elected invention.

Upon further review of the previous office action, it became apparent that the previous restriction letter was incomplete due to lack of sufficient definition of SEQ ID NO:s recited in claims and hence, further restriction deemed necessary as following:

Group I(a): claims 1-5, 7-10, 18-20, drawn to isolated polynucleotides encoding a variant of osmosensing histidine kinase from *Fusarium oxysporum* (SEQ ID NO:41-42) and host cells transformed with said products, classified in class 435, subclass 252.3

Group I(b): claims 1-10, and 18-19, drawn to isolated polynucleotides encoding a variant of osmosensing histidine kinase from *Botryotinia fuckeliana* (SEQ ID NO:13, 1, and 2) and host cells transformed with said products, classified in class 435, subclass 252.3.

Group I(c) : claims 1-5, 7-10, and 18-20, drawn to isolated polynucleotides encoding a variant of osmosensing histidine kinase from *Mycosphaella tritici* (SEQ ID NO:55-56) and host cells transformed with said products, classified in class 435, subclass 252.3.

Group I(d) : claims 1-5, 7-10, and 18-20, drawn to isolated polynucleotides encoding a variant of osmosensing histidine kinase from *Thanatephorus cucumeris*

Art Unit: 1653

(SEQ ID NO:68-69) and host cells transformed with said products, classified in class 435, subclass 252.3.

Group I(e) : claims 1-5, 7-10, and 18-19, drawn to isolated polynucleotides encoding a variant of osmosensing histidine kinase from *Phytophthora infestans* (SEQ ID NO:90) and host cells transformed with said products, classified in class 435, subclass 252.3.

Group I(f), claims 1-5, 7-8, and 18, drawn to isolated polynucleotides encoding a variant of osmosensing histidine kinase and transformed host cells with an osmosensing histidine kinase coding sequence from *Magnaporthe grisea*, classified in class 435, subclass 252.3

Group VI: claim 22, drawn to oligonucleotides which comprise SEQ ID NO:30-40, 52-53, 64-65, 85-86 classified in class 536, subclass 23.1.

The inventions of Groups Ia-I f and VI are each patentably distinct from the other because each invention is directed to a product of unrelated chemical structure and function. Applicant is reminded that this is **not a species election**.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

Art Unit: 1653

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

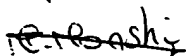
Applicant is further reminded that in case he/she decides to elect the invention of Group VI the Office only permits a maximum of 10 SEQ ID NO:s per invention for search purposes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maryam Monshipouri whose telephone number is (571) 272-0932. The examiner can normally be reached on 7:00 a.m to 4:30 p.m. except for alternate Mondays.

Art Unit: 1653

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weber Jon P. can be reached on (571) 272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Maryam Monshipouri Ph.D.

Primary Examiner
